

### **REMARKS**

Claims 1-4, 15, 16, 18 and 19 are all the claims pending in the application. By this Amendment, Applicant amends claims 1 and 3 to further clarify the features claimed therein and adds claims 20-27, which are clearly supported throughout the specification.

#### **I. Summary of the Office Action**

Claims 1-4, 15, 16, 18 and 19 are all the claims pending in the application. The Examiner found new grounds for rejecting the claims. Claims 2-4, 15, 16, and 19 are provisionally rejected on the ground of non-statutory obviousness-type double patenting and claims 1-4, 15, 16, 18, and 19 are rejected under 35 U.S.C. § 103(a).

#### **II. Double Patenting Rejection**

Claims 2-4, 15, 16, and 19 are provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 10/692,011 in view of U.S. Patent No. 4,230,683 to Decker et al. (hereinafter “Decker”). Applicant respectfully requests that the Examiner hold in abeyance this provisional double patenting rejection.

#### **III. Prior Art Rejections and Statement of Substance of Interview**

Claims 1-4 15, 18, and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2003/0186463 to Hudak et al. (hereinafter “Hudak”) in view of U.S. Patent No. 7,258,837 to Yager et al. (hereinafter “Yager”), U.S. Patent No. 4,230,683 to Decker et al. (hereinafter “Decker”), U.S. Patent No. 3,875,011 to Rubenstein et al. (hereinafter “Rubenstein”), and U.S. Patent No. 5,260,222 to Patel et al. (hereinafter “Patel”). Applicant

respectfully traverses these grounds of rejection at least in view of the following exemplary comments.

Applicant thanks the Examiner for the courteous telephonic interview on November 3, 2008. An Examiner's Interview Summary Record (PTO-413) was mailed to the Applicant on November 5, 2008. The PTO-413 requires the Applicant to file a Statement of Substance of the Interview. The Statement of Substance of the Interview is as follows:

During the interview independent claim 1 was discussed in view of the prior art of record. The Examiner further clarified her position that if claim 1 is amended as set forth in this Amendment, the rejection of record should be overcome subject to an updated search.

In particular, independent claim 1 recites *inter alia* "respectively spotting the receptors or ligands onto a surface of the biochemical analysis unit provided with the plurality of porous adsorptive regions and wherein the reaction liquid containing the enzyme-labeled antibody is forced to flow in a direction transverse to said surface and into an interior of each of the porous adsorptive regions of the biochemical analysis unit and exit on the other side of each of the porous adsorptive regions thereby flowing through each of the porous adsorptive regions such that the reaction liquid containing the enzyme-labeled antibody is pumped through the biochemical analysis unit with the plurality of the porous adsorptive regions and exits on another side of the biochemical analysis unit, wherein, at a time at which the enzyme-labeled antibody is subjected to the specific binding with the labeled receptor or the labeled ligand, which has been specifically bound to at least one of the ligands or at least one of the receptors, a reaction liquid containing the enzyme-labeled antibody is forcibly caused to flow such that the reaction liquid containing the enzyme-labeled antibody flows across each of the porous adsorptive regions of

the biochemical analysis unit and through the biochemical analysis unit and exits on other side of the biochemical analysis unit.”

The Examiner acknowledges that Hudak, Yager, Decker, and Rubenstein do not disclose or suggest the above-noted unique features of claim 1. In the Office Action, the Examiner relied on Patel to cure these deficiencies (*see* pages 7, 9, and 12 of the Office Action). Applicant respectfully disagrees.

First, as acknowledged by the Examiner, Patel only discloses having the liquid flow across and be absorbed by the bibulous materials 60 and 78. In other words, Patel clearly fails to disclose or even remotely suggest having the liquid flow in a direction transverse to the surface of the unit and through the bibulous material *i.e.*, the liquid exiting on the other side of the bibulous material. On the contrary, as is clearly visible from Figs. 5A and 5B of Patel, the liquid only flows across the bibulous material (col. 11, line 66 to col. 12, line 22).

Second, Patel does not disclose or even remotely suggests that the liquid is forced to flow through the bibulous material. On the contrary, in Patel, the methods and devices allow for capillary flow of liquid between two or more pieces of bibulous material which, prior to actuation, are in a non-capillary flow relationship (*see* Abstract). Capillary action of Patel cannot be considered forcible flow as the liquid flows naturally and is not forced via a pump or some other device. In short, Patel does not disclose or even remotely suggest pumping the liquid through the bibulous material.

Third, the proposed combination is unworkable. Patel discloses a breakable, sealed capsule. That is, the bibulous material is encased by a housing. Since Patel's capsule is sealed

by a housing, it would be impossible to implement the spotting as suggested by Yager. That is, Yager and Patel cannot be combined with each other to obtain workable combination.

For at least these exemplary reasons, claim 1 is patentable over Hudak in view of Yager, Decker, Rubenstein and Patel. Accordingly, it is appropriate and necessary for the Examiner to withdraw this rejection of claim 1 and its dependent claim 2.

It is respectfully submitted that the instant STATEMENT OF SUBSTANCE OF INTERVIEW complies with the requirements of 37 C.F.R. §§1.2 and 1.133 and MPEP §713.04.

Next, independent claim 3 recites features similar to, although not necessarily coextensive with, the features argued above with respect to claim 1. Therefore, arguments presented with respect to claim 1 apply with equal force here. For at least substantially analogous exemplary reasons, therefore, independent claim 3 is patentable over the prior art of record. Claims 4, 15, 18, and 19 are patentable at least by virtue of their dependency on claim 3.

Claim 16 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Hudak in view of Yager, Decker, Rubenstein, Patel, and U.S. Patent No. 6,846,638 to Shipwash (hereinafter "Shipwash"). Applicant respectfully traverses these grounds of rejection at least in view of the following exemplary comments.

Claim 16 depends on claim 3. It was already demonstrated that the combined teachings of Hudak, Yager, Decker, Rubenstein, and Patel do not meet all the requirements of independent claim 3. Shipwash fails to cure the deficient teachings of these references. Together, the combined teachings of these references would not have (and could not have) led the artisan of ordinary skill to have achieved the subject matter of claim 3. Since claim 16 depends on claim 3, it is patentable at least by virtue of its dependency.

IV. New Claims

In order to provide more varied protection, Applicant adds claims 20-27, which are patentable by virtue of their dependency and for additional features set forth therein.

V. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. **If any points remain in issue, the**

**Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.**

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


Respectfully submitted,

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